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Rhonda Dunn

In re Application of: Peppel, et al

Docket No.: OOMP0001C

Serial No. : 09/735,586

Art. Unit: 2132

Filed: 12/12/2000

Examiner: LANIER, Benjamin

Title: Electronic Trading Card

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SEP 15 2004

September 9, 2004

Technology Center 2100

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Re: **Appellant's Rebuttal**

Attached to this facsimile coversheet please find the following document:

1. Appellant's Rebuttal (6 Pages), Submitted In Triplicate (18 Total Pages); And
2. Return Postcard

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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SEP 15 2004

Technology Center 2100

Application Number: 09/735,586

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Appellant: Peppel

Date: September 9, 2004

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**BOARD OF PATENT APPEALS
AND INTERFERENCES**

Michael A. Glenn

For Appellant

APPELLANT'S REBUTTAL TO THE EXAMINER'S ANSWER

REMARKS

This Rebuttal Brief is submitted in response to the Examiner's Answer, which was mailed from the Patent Office on 09 August 2004. The Examiner's Response to Argument consists of three points, *i.e.* 1) that the Appellant's Declaration is flawed, 2) that the Appellant's Declaration fails to show conception, and 3) that the Appellant's Declaration fails to establish diligence.

With regard to the flaws in the Declaration, Appellant is of the opinion that these formalities may be readily addressed outside of this proceeding, should the issues of conception and diligence be overcome. It appears from the Examiner's comments on page 6 of the Examiner's answer that these formal issues with the Declaration do not provide an insurmountable obstacle to obtaining patent protection for the claimed invention.

Appellant addresses the issue of diligence first, and then addresses the issue of conception.

The Examiner's argument with regard to diligence in reduction to practice focuses on a period from 02 December 1994 until 06 March 1995, *i.e.* about four months. During this time, and this is acknowledged by the Examiner, a search was received by Appellant and a patent application was prepared for Appellant. Thus, there is no inactivity for which Appellant must make an excuse. Rather, Appellant has accounted for the entire period during which diligence is required.

The Examiner acknowledges that a patentability search was received by the inventor on 02 December 1994 and that the inventor met with Appellant's attorney on 04 January 1995. Given the Holiday season and the time it would have taken the inventor to consider the search results, it is not unreasonable that a one month period would have passed. The Examiner, however, unreasonably and arbitrarily takes the position that "a gap of approximately one month over a

critical period spanning the date of the reference" indicates that "there was no showing of diligence from prior to the reference date" and that "diligence is not proved for the entire period."

With regard to the showing of diligence prior to the reference date, Appellant has alleged conception at least as early as 07 September 1994. It is uncontested that the Appellant received search results for his invention on 02 December 1994. Thus, during an approximately two month interval the inventor investigated the patentability of the invention. A two month interval during which such investigation takes place cannot possibly be construed as an inactivity or abandonment of reduction to practice by the Appellant. Here, the Examiner is arbitrary in determining that diligence is lacking. Further, a one month interval from the time the search results were received until the initial meeting with the Appellant's attorney is not unreasonable.

The period from 04 January 1995 until 22 January 1995 is also pointed out by the Examiner as being a period of inactivity. This is a period of less than three weeks during which Appellant's attorney, as supported by a declaration, was involved in the process of preparing a patent application. The Examiner admits that the Appellant's attorney recites a list of activities which occurred during this time frame and provides supporting exhibits for two of these activities. Unreasonably, the Examiner then concludes that there is "no indication as to whether this qualifies as reasonable diligence on the part of the attorney." Further, while the Examiner indicates that "the time span does not appear to be unreasonable" the Examiner indicates that the patent office "will not speculate as to the conditions of the attorney's docketing practice." So the Examiner is saying that while the interval is not unreasonable, he still considers it unreasonable!

Appellant's attorney finds this line of reasoning to be entirely inconsistent with the Patent Office rules and totally out of line with established legal precedent. The Examiner here is nit-picking an interval of barely three months from the time the

Appellant received the search results until the time the Appellant's attorney completed the application. What would the Examiner have the Appellant's attorney do to establish diligence in drafting the patent application, submit billing records?

Appellant has concentrated on this aspect of the Examiner's argument to point out the unfairness of the situation that the Appellant finds himself in, where the Examiner arbitrarily refuses to accept the Appellant's evidence and applies a Draconian standard in supporting his rejections.

Appellant has also provided undeniable evidence of conception. The Examiner focuses on the limitation "computer code segment further embodied in electronic format that supports content scarcity and content authenticity." The Examiner concludes that there is no evidence to support conception for these means and their interaction with the system. The Examiner misapplies *MPEP 715.07* in his analysis. This section of the MPEP concerns, *inter alia*, the explanation provided by Appellant about the exhibits. Appellant has not made vague and general statements in broad terms about what the exhibits describe. Appellant's statements are supported by proof and a showing of facts, specific references to supporting documents and clear supporting statements. Appellant has given a clear explanation of the exhibits pointing out what facts establish and relied upon by the Appellant. Appellant's Declaration does assert facts that exist and does tell where they are and when they occurred. This clearly belies the Examiner's statement that "Appellant has provided no explanation of which facts or data Appellant is relying on to show completion of his or her invention prior to a particular date."

The Examiner places significant emphasis on the claim language and looks to find a mapping of the exact claim language to the Appellant's early conception documents, which were discussed in the Appellant's Appeal Brief and which form a part of this record. It is readily appreciated by a reasonable person that an

inventor, when conceiving an invention, may not use the same terminology as that which winds up in the patent claims. The significant inquiry goes to the invention itself. The claimed invention should have been conceived and this conception should be supported by the evidence submitted.

Here, the Examiner has fixed upon the term "computer code segment further embodied in an electronic format that supports content scarcity and content authenticity." Appellant's evidence discloses floppy disks, online servers, CD-ROMs, PCIMA Cards (see document C1). Thus, Appellant's evidence of conception shows an electronic format. The various card collecting scenarios identified, for example in document PC2, support the notion of scarcity and authenticity. The notion of a computer coded segment is supported in document C1 ("E-CARDS are small multimedia software programs").

The Examiner, not being satisfied with this irrebuttable evidence, nonetheless adds a further requirement that the evidence provide support of conception for the means themselves "and their interaction..." Appellant meets this requirement as well. The evidence supports computer code segments and a tangible medium upon which these segments are provided. The evidence then provides scenarios in which these cards can be used to support authenticity and card scarcity. The interaction is clear from the claim language, *i.e.* the electronic trading cards (ETC) will allow various trading cards scenarios in an electronic format, *i.e.* computer code stored on a tangible medium, when executed, provides an electronic trading card that supports content scarcity and authenticity. The evidence shows this! The specific details of how this is done are the subject of reduction to practice and are pointed out in the patent application. Clearly, the Examiner cannot expect the invention to be completed the moment it is conceived. This is the purpose of reduction to practice. However, the Examiner appears to be applying this standard.

In summary, the Examiner's position with regard to diligence is unreasonable, arbitrary, and inconsistent with the position taken by the Board in the parent application from which this application derives its priority. Further, the Examiner has placed upon the Appellant an unreasonable burden with regard to providing conception. Appellant's evidence clearly supports conception and the Examiner has apparently contrived a further test beyond that required, *i.e.* that the conception also provide a fully enabled and complete embodiment, *i.e.* that conception must also include reduction to practice at the same time.

Appellant apologizes in advance if the tone of this submission is a bit harsh. No disrespect for the Examiner is meant. Appellant is merely expressing frustration at the protracted prosecution and considerable expense imposed by the process of obtaining the patent protection for which Appellant is entitled, which expense and delay appears to result from the Examiner's seemingly arbitrary rejection of Appellant's evidence.

Respectfully submitted,

A handwritten signature in dark ink, appearing to be 'Michael A. Glenn', with a long horizontal flourish extending to the right.

Michael A. Glenn
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